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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,013	01/08/2001	Jean M. Beaupre	END0701USNP	7092
27777	7590	11/13/2007		
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER ALI, SHUMAYA B	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/757,013	Applicant(s) BEAUPRE, JEAN M.	
	Examiner Shumaya B. Ali	Art Unit 3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9,11-13,15-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6,11-13,15,17 and 22 is/are rejected.
- 7) ☒ Claim(s) 5,7-9,16,18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

No amendment to claims is made in response to the office action mailed on 4/19/07. Claims 2,3,14, and 21 are previously cancelled. Currently, claims 1,4-13,15-20, and 22 are pending in the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Strukel US 5,242,385.

As to claim 1, Strukel discloses a laminated ultrasonic (co.2, lines 44-46) end effector (fig.1ab) having a distal (see fig.1b) end and a proximal end (see fig.1a) and comprising at least two stamped pieces (fig.1a, 20ab) of sheet stock which are laminated together and at least one lumen (fig.1a, 15) extending from the distal end to the proximal end (see fig.2, and col.2, lines 60-65).

As to claim 4, Strukel discloses the laminated ultrasonic end effector of claim 1, wherein the laminated ultrasonic end effector defines a connector (Strukel teaches an “ultrasonic handpiece”, see col.2, lines 44-46, therefore inherently teaches a connector that allows the

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handpiece to be charged or receive ultrasonic energy) at a proximal end of the laminated ultrasonic end effector to receive ultrasonic energy from an acoustic transmission assembly.

As to **claim 6, Strukel** discloses the laminated ultrasonic end effector of claim 1, wherein a distal portion of each of the stamped pieces of sheet stock has a longitudinal rib (**fig.2, 28**) stamped therein extending along the longitudinal axis of the laminated ultrasonic end effector to provide lateral stiffness for the laminated ultrasonic end effector.

As to **claim 11, Strukel** discloses the ultrasonic waveguide of claim 1, wherein a piece of sheet stock (**fig.1a, 12**) is mounted and secured to longitudinally extending slots in an outer circumference of a separate threaded connector (**fig.1a, 110**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12,13,15,17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strukel US 5,242,385.

As to **claims 12,13,15,17, and 22, Strukel** lacks a detailed description of the claimed steps, however discloses structural limitations required to perform the method steps (see above

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rejection cited for claims 1,4,6, and 11). Thus, the method steps as cited in claims 12,13,15,17, and 22 would have been obvious result of using the apparatus of Strukel.

Response to Arguments

Applicant's arguments filed on 8/30/07 have been fully considered but they are not persuasive. In the remark filed on 8/30/07 Applicant argued, "Nowhere does Strukel disclose or suggest a laminated end effector (i.e. the tip) as is positively recited in independent claims 1 and 12. The Examiner is taking the laminated structure disclosed in conjunction with the handpiece (or transducer—See Abstract) and improperly applying the lamination structure to the end effector as recited in the claims. The handpiece (transducer) and the tip (end effector) are different structures within both the Strukel reference and the claimed invention" (see page 8, lines 3-9), this argument however is not well taken. It appears that Applicant is arguing for an ultrasonic device that (1) has an end piece, i.e., "end effector", which is (2) positioned at a specific location with respect to the device (i.e., end of the handpiece), however, such location/position of the end effector is not supported by the claim. Thus, claimed "end effector" is not limited to a device that is only positioned at the end of the handpiece. Furthermore, in order to anticipate "a laminated ultrasonic end effector" one of ordinary skill in the art would look for an ultrasonic device that has laminated feature(s). Therefore, Strukel's handpiece comprising a laminated structure (fig.2, 20ab) anticipates "laminated ultrasonic end effector" as recited in the claims. Thus, rejection set forth in the previous office action is maintained.

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Allowable Subject Matter

Claims 5,7-9,16, and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-W-F 8:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Shumaya B. Ali
Examiner
Art Unit 3771


JUSTINE R. YU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700
11/9/07